



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/618,957 | 07/14/2003 | Mitsushi Yamamoto | UNIU79.013AUS | 6418 |

20995 7590 03/31/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on January 23, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Application Serial Nos. 10/969236, 11/090813, 11/073456 and 10/619516 have been reviewed and are accepted. The terminal disclaimer has been recorded.

Objection Withdrawn

2. Objection to the Abstract has been withdrawn in view of the amended abstract filed on January 23, 2006.

Rejections Withdrawn

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, made in the last Office Action has been withdrawn in view of the amendment filed on January 23, 2006.

Response to Arguments

4. Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1772

6. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by The English Abstract of Australian AU 9640808A of July 11, 1996.

The English Abstract relates to an adhesive polyester film comprising a polyester film and an adhesive coating on at least one side of the film. The adhesive comprises a carboxylic acid group-containing copolymer and one cationic polymer having pyrrolidinium rings in the main chain. When the adhesive is present on both sides of the film, the structure, as interpreted by the examiner, comprises an adhesive layer on one side and the pyrrolidinium ring containing cationic polymer on the other side. The Abstract further mentions that the laminate exhibits excellent antistatic properties. It is also understood by the examiner that the polyester film is transparent, the acrylic based adhesive is transparent and the antistatic layer is also transparent, as is admitted in the instant application.

Further, the laminate would inherently exhibit the maintaining of transparency even after one-hour heat treatment at 150 degrees C.

The intended use phrases such as "for transparent conductive substrates", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

7. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Malhotra (5534374).

Malhotra relates to a laminate (figure-1) comprising a transparent polyester substrate (2) with adhesive (4) on one side and antistatic layer (41) on the other side. The

Art Unit: 1772

adhesive can be acrylic-based, which are known to be transparent as admitted by the applicant in the specification, page-8. The antistatic layer comprises a binder and an antistatic agent, such as pyrrolidine acid salt compounds and would be inherently transparent as admitted by the application the specification, page-12. See col. 6, line 62-col. 7, line 10; col. 12, lines 51-63; col. 14, lines 44-46 and 65-68; and col. 30, line 21 – col. 32, line 34.

The laminate will inherently exhibit the maintaining of the transparency as discussed above.

The intended use phrases have not been given any patentable weight as discussed above.

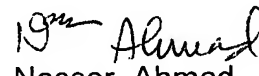
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 3/28/06
Primary Examiner
Art Unit 1772

N. Ahmad.
March 28, 2006.